

REMARKS/ARGUMENTS

Claims 1-2, 5-8 and 10-29 are pending in the application. All of these claims are rejected.

In this response, claim 1 is amended to more clearly define applicants' nail varnish. Further, new claims 30 and 31, depending from claim 1, are proposed for entry into the application. The claim amendments and the new claims are, as discussed further below, entirely supported by the application as originally filed. Thus there is no issue of new matter. Still further, claims 17-26 and 29 are cancelled from the application without prejudice or disclaimer. Entry of the amendments and new claims into the file of the application is respectfully requested. Following such entry, claims 1, 2, 5-8, 10-16, 27-28 as amended and new claims 30-31, will be pending in the application.

Reconsideration of the application based on the claim amendments and corresponding remarks presented herein is respectfully solicited.

Claim Rejections Under 35 U.S.C. §103

On p. 3 of the Office Action claims 24-26 and 29 are rejected under 35 U.S.C. §103 over U.S. Patent No. 4,321,087 of Levine et al., as evidenced by *PVD Aluminum Pigments: Superior Brilliance for Coatings & Graphic Arts* by Seubert, in view of U.S. Patent No. 5,624,076 to Miekka, et al.

In response applicants submit that these rejected claims are all canceled herein from this application, such cancellation being without prejudice or disclaimer. The cancellation, therefore, renders the present rejection moot and it thus should be withdrawn.

Further to the above, at p. 4 claims 1-2, 5-8, 10-16, 18, 21-22 and 27-28 are rejected under 35 U.S.C. §103 as being allegedly obvious over Levine et al. '087, as evidenced by Seubert, in view of Miekka et al. '076, as applied to claims 24-26 and 29, and further over U.S. Patent Publication No. 2003/0175225 of Leacock et al. In response applicants note that claims 18 and 21-22 have been cancelled herein without prejudice or disclaimer. Thus the rejection is rendered moot as to those claims. With regard to the remainder of the rejected claims, i.e., nos. 1-2, 5-8, 10-16 and 27-28, the rejections are respectfully traversed, however.

Of the subject rejected claims, only claim 1 is written in independent form. The remaining claims all depend, directly or indirectly, from claim 1 and thus they include all of the features recited in the independent claims. In response to the rejection under §103, claim 1 has

been amended to more clearly define applicants' nail varnish. In particular, the claim as amended now recites that the nail varnish comprises a solvent in an amount of from 50% to 90% by weight, based on the total weight of the nail varnish. Support for this amendment is found, for example, in paragraph [0043] of the published U.S. application (US 2007/0207099).

Claim 1 is additionally amended herein, furthermore, to include a proviso excluding pearl luster pigments from the claimed nail varnish, i.e., wherein the amended claim reads, "with the proviso that the nail varnish does not include pearl luster pigments". As explained below support for the proviso is believed to be present in paragraph [0048] on p. 3 of the application publication, No. 2007/0207099. Applicants believe, for the reasons expressed below, that the proviso added to claim 1 meets all of the statutory requirements and, thus, it should be entered into the file of the application and its effect on the patentability of the claims considered by the Examiner.

M.P.E.P. §2173.05(i), headed Negative Limitations – 2100 Patentability, states that, "The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph." The Manual (MPEP) additionally states, moreover, that, "any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternate elements are positively recited in the specification, they may be explicitly excluded in the claims."(emphasis supplied by applicants). Applicants submit that the above situation is exactly what has occurred in the present case. That is, the present application specifically mentions and describes a variety of "additives" which may be incorporated into the nail varnish. Among such "additives", as described in paragraph [0048] of the application publication, are "pearl luster pigments". It is these, "pearl luster pigments", i.e., among a number of possible "additives" that are specifically excluded from claim 1, and thus the rest of the rejected claims (i.e., that depend from claim 1), by the proviso.

Applicants note, further, that the facts of the present case are along the same lines as those of the *In re Johnson*, 194 USPQ 187, 196 (CCPA 1977) the decision of which is specifically adopted by the Patent Office in M.P.E.P. 2173.05 (i). The *Johnson* decision notes that the applicants in that case set forth a broad genus, including a number of specific examples, wherein the applicants then attempted to exclude some of the specific examples of those items

from the claims with the use of a proviso. The Court, in holding that the proviso was entirely proper, stated (at p. 196), “The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.” In a similar manner, all applicants in the case of the present application have done is to narrow their claims to eliminate pearl luster pigments therefrom, which form no part of their invention, so as to distinguish their claims further from the prior art cited in the present Office Action. Based on the reasoning above, therefore, applicants respectfully request the Examiner to enter and consider the effect of the subject proviso, which effect is clarified by the discussion that follows.

Claim 1 as amended is directed to:

A nail varnish having a metallic and multicolored iridescent appearance, comprising a liquid phase, at least one film-forming component, at least one of a plasticizer and a dispersing agent and a PVD aluminum pigment, wherein said PVD aluminum pigment has diffractive structures containing from approximately 5,000 to approximately 20,000 structural elements per cm and a metallic aluminum content of from 90 to 100% by weight, based on the weight of the aluminum pigment, and is present in the nail varnish at a pigmentation level of from 0.05 to 5.0% by weight, based on the total weight of the nail varnish, wherein the nail varnish also comprises a solvent in an amount of from 50% to 90% by weight, based on the total weight of the nail varnish, and with the proviso that the nail varnish does not include pearl luster pigments.

In contrast to the nail varnish as defined in claim 1 applicants submit that both the Levine et al. and the Miekka et al. references describe formulations comprising a greater amount of solvent than that recited for use in applicants’ claimed nail varnish. That is, the solvent content taught by these references is > than 90%. See, for example, Levine et al. ‘087 Examples 9 and 10 and Miekka et al. Examples 12 and 13. Thus, the proposed combination of Levine et al., Seubert, Miekka et al. and Leacock et al. would teach the ordinary skilled artisan in this field of art to use a solvent concentration of >90%, i.e. which is outside of the range now recited in applicants’ claim(s). Even further away from the level(s) of solvent taught for use in the cited

prior art are those levels recited in new claims 30 and 31. Support for these new claims is contained in paragraph [0043] of the publication of the application, no. 2007/0207099 A1. Claim 30 states that the solvent content is from 50% to 85% by weight, i.e., even further away from the prior art. Additionally, new claim 31 recites a solvent content of from 50% to 75%. Thus, both of these new dependent claims are distinguishable on the same basis as described above with regard to claim 1.

A further ground of distinction, moreover, concerns the above-described proviso added to claim 1, i.e., wherein “the nail varnish does not include pearl luster pigments”. Turning, in this regard, to Leacock et al., the subject reference describes a nail enamel composition (see, e.g., para. [0008]), “. . . exhibiting color changes, which changes may vary depending upon the angle of view over a metallic background . . .” (emphasis supplied by applicants). A nail enamel composition according to the teaching of Leacock et al. includes *inter alia* (see para. [0010]), “. . . a pigment based on silicon dioxide in the form of platelets, which platelets are coated with a metal oxide, and aluminum platelets.” (emphasis supplied by applicants). Pigments based on silicon dioxide in the form of platelets (as disclosed by Leacock et al.), which platelets are coated with a metal oxide, displaying an angle dependent color impression resulting from a perceived color change which varies with the viewer’s angle (see Leacock et al. para. [0014]). These are known as pearl luster pigments. The metallic background of a nail enamel composition according to the teaching of Leacock et al. is provided by the aluminum platelets.

Turning, then, to a discussion of applicants’ claimed nail varnish, applicants’ object as taught in the present specification is to prepare a nail varnish that, when applied, produces a multi-colored iridescence as well as a lustrous metallic effect, giving the impression of being a preferably cohesive metallic layer (see, e.g., para. [0016] of Pub. No. 2007/0207099 A1, i.e., the present application). This object has been achieved in the case of the present invention by providing a nail varnish comprising, *inter alia*, the PVD aluminum pigment recited in claim 1 having the claimed diffractive structures. In contrast to the teaching contained in Leacock et al., the metallic and multicolored iridescent appearance of the claimed nail varnish composition after application is obtained by the incorporation of only the PVD aluminum pigment recited in claim 1 without the need for including any pearl luster pigments. Thus, the presence of the proviso now set forth at the end of claim 1 serves to further distinguish the claimed nail varnish over the

combination of references cited to reject, e.g., claim 1 due to the fact that the claim in its present form now excludes what is a required element according to Leacock et al., pearl luster pigments.

Since, then, the revised language of claim 1 now clearly distinguishes the nail varnish recited therein over the cited combination of references relied upon to reject claim 1, *et seq.*, the Examiner is respectfully requested to reconsider and withdraw the rejection of the subject claim under 35 U.S.C. 103 of claim 1. Furthermore, since the remainder of the claims included in the subject rejection, i.e., nos. 2, 5-8, 10-16 and 27-28, all depend directly or indirectly from claim 1, they are all also believed to be distinguishable for the same reasons as claim 1. Thus the rejection of each of claims 1-2, 5-8, 10-16 and 27-28 should be withdrawn.

Further to the above, at p. 7 of the Action claims 17, 19-20 and 23 are rejected under 35 U.S.C. §103. In response, applicants note that the rejected claims are among those that are cancelled from the application in this response, such cancellation being without prejudice or disclaimer. The cancellation of these claims, therefore, renders moot the present rejection, which should therefore be withdrawn.

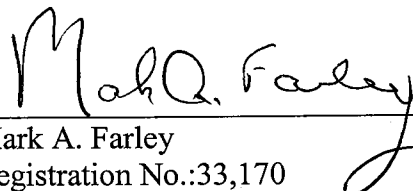
Summary

The claim amendments and arguments presented herein are believed sufficient to overcome the rejection of all of the claims remaining in the present application. The Examiner is, therefore, respectfully requested to withdraw all of the claim rejections and to issue a Notice of Allowance for all of the claims now pending.

THIS CORRESPONDENCE IS BEING
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MAF: ck

Respectfully submitted,



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